

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 9-17, 23, 25-33, 35-40, 42-44, and 47 are pending in this application. Claims 17, 23, 25-27, 32, 33, and 35-37 are amended and Claims 18-22, 24, 34, 41, 45, and 46 are canceled without prejudice or disclaimer by the present amendment. No new matter is added.

In the outstanding Official Action, Claims 17-32 were rejected under 35 U.S.C. §101; Claims 23, 31, 33, and 41 were rejected under 35 U.S.C. §103(a) as unpatentable over Limon, Jr. et al. (U.S. Patent No. 6,453,435, herein "Limon") in view of Nagasaki et al. (U.S. Patent No. 6,278,797, herein "Nagasaki"); Claims 45 and 46 were rejected under 35 U.S.C. §102(e) as anticipated by Limon; and Claims 17 and 19-22 were rejected under 35 U.S.C. §102(e) as unpatentable over Harrison (U.S. Patent No. 6,421,071). However, Claims 18, 24-30, and 34-40 were indicated as including allowable subject matter. Claims 9-16, 42-44, and 47 were allowed.

Applicant acknowledges with appreciation the allowance of Claims 9-16, 42-44, and 47 any indication that Claims 18, 24-30, and 34-40 including allowable subject matter.

With respect to the rejection of Claims 17-32 under 35 U.S.C. §101, Claims 18-22 and 24 are canceled without prejudice or disclaimer herewith, making this rejection moot with respect to these claims. It is respectfully noted that Claims 17, 23, and 25-31 are directed to an information processing apparatus, and Claims 23 and 25-31 recite means-plus-function terminology.

Proper claim interpretation of a means-plus-function (35 U.S.C. § 112, 6th paragraph) element entails consideration of the structures disclosed in the specification and equivalents thereof.

In determining the scope of the claims prior to determining compliance with each statutory requirement for patentability, MPEP §2106 provides:

Office personnel are to correlate each claim limitation to all portions of the disclosure that describes the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined using means or step plus function language. The correlation step will ensure that office personnel will correctly interpret each claim limitation. (emphasis added).

Thus, Applicant respectfully submits that the rejection under 35 U.S.C. §101 of at least Claims 17, 23 and 25-31 are improper as these claims clearly recite apparatus claim limitations.

MPEP § 2106 further provides that:

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitations to a practical application in a technological arts should it be rejected under 35 U.S.C. § 101 . . . Further, when such a rejection is made, office personnel must expressly state how the language of the claims has been interpreted to support the rejection. (emphasis added) See MPEP § 2106.

The rejection merely includes the conclusory statement that Claims 17 and 23 “are directed to system of functional descriptive material per se, and hence non-statutory”¹ Thus, Applicant respectfully submits that no express statement has been provided as to how the language of the claims have been interpreted to support the 35 U.S.C. §101 rejection in violation of the guidelines of MPEP §2106.

Accordingly, should such a rejection be maintained in a subsequent communication with respect to any of the aforementioned claims, it is respectfully requested that the Examiner provide an express statement on the record in accordance with MPEP §2106 guidelines explaining how such claim terminology, such as “a data sampling section,” “means for reading,” and “means for displaying” is interpreted. More specifically, how such

¹See the outstanding Office Action at page 3, lines 17-18 and page 5, lines 6-7.

limitations are deficient to define a useful, concrete and tangible result. See State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1374, 47 (Fed. Cir. 1998) (discussing practical application of a mathematical algorithm, formula, or calculation.).

Further, computer programs are often recited as part of a claim. U.S.P.T.O. personnel should determine whether the computer program is being claimed **as part of an otherwise statutory manufacture or machine**. In such a case, the claim **remains statutory irrespective of the fact that a computer program is included in the claim.**²

Thus, Claims 17 and 23 recite apparatuses, which is one of the statutory types recited in 35 U.S.C. §101. Finally, with regard to Claim 32, amended Claim 32 recites a “computer readable medium,” which is an article of manufacture. Accordingly, Claims 17 and 23-32 are believed to be in compliance with all requirements under 35 U.S.C. §101.

With regard to the rejection of Claims 23, 31, 33, and 41 under 35 U.S.C. §103(a) as unpatentable over Limon in view of Nagasaki, Claim 23 is amended to include the subject matter of Claim 24, which was indicated as including allowable subject matter. Accordingly, amended Claim 23 (and Claims 25-31 dependent therefrom) is believed to be allowable.

Claim 33 is amended to include the subject matter of Claim 34, which was indicated as including allowable subject matter. Accordingly, amended Claim 33 (and Claims 35-40 dependent therefrom) is believed to be allowable.

Claim 41 is canceled without prejudice or disclaimer, making this rejection moot with respect to that claim.

With regard to the rejection of Claims 45 and 46 under 35 U.S.C. §102(e) as anticipated by Limon, Claims 45 and 46 are canceled without prejudice or disclaimer, making this rejection moot.

² See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, USPTO 2005 (Annex IV, Computer Related Non-Statutory Subject Matter) page 53

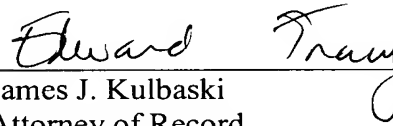
With regard to the rejection of Claims 17 and 19-22 under 35 U.S.C. §102(e) as unpatentable over Harrison, Claims 19-22 are canceled without prejudice or disclaimer, making this rejection moot with respect to these claims.

Claim 17 is amended to include the subject matter of Claim 18, which was indicated as including allowable subject matter. Accordingly, amended Claim 17 is believed to be allowable.

Accordingly, in view of the present amendment, no further issues are believed to be outstanding and the present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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